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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,695	02/25/2004	Neal Dulaney	35269US1	3686

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EXAMINER
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VALENTI, ANDREA M

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/786,695

Applicant(s)

DULANEY, NEAL

Examiner

Andrea M. Valenti

Art Unit

3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5,9-18 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,9-18 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 21 has been renumbered 30.

Applicant needs to provide a complete listing of all of the claims, so applicant needs to indicate that claims 21-29 have been cancelled or are currently withdrawn until the application is condition for allowance at which time they can be cancelled.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 3, 9-13, 16-18, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,782,204 to Rahn in view of U.S. Patent No. 5,098,585 to Woltman.

Regarding Claims 1, 9, 18 and 30, Rahn teaches a modular water flow system for an aquarium comprising: a pump (Rahn Col. 4 line 40 "from the pump or powerhead of filter 3" and Col. 2 line 15); a water intake system (Rahn #4) having an interior portion

Art Unit: 3643

inside the aquarium and an exterior portion outside the aquarium wherein the water intake system pulls water in from the aquarium through at least one inlet due to a propulsive force created by the pump; a water return system (Rahn #8, 9, 10) having an interior portion inside the aquarium and an exterior portion outside the aquarium wherein the water return system permits the water to return to the aquarium from at least one outlet; and at least one valve (Rahn #2 and Col. 4 line 35 and Col. 2 line 35) assembly to manage at least one of the water return system and the water intake system to regulate a flow rate; an overall assembly unit which couples the interior portions of the modular water flow system to the exterior portions of the modular water flow system via a link wherein the link comprises at least one inlet port which is connected to at least one of the interior portions of the modular water flow system and at least one outlet port which is connected to at least one of the exterior portions of the modular water flow system (Rahn Fig. 1 and 2 see attached);

Rahn teaches that the inlet port is attached to an interior portion (Rahn #4) and an outlet port is attached to an exterior portion, but is silent on the at least one inlet port is rotatably coupled to the corresponding interior portion of the modular water flow system and an outlet port is rotatably coupled to the exterior portion. However, Woltman teaches it is old and notoriously well-known to rotatably couple portions of an aquarium assembly inlet/outlet (Woltman Col. 6 line 45-51). It would have been obvious to one of ordinary skill in the art to modify the teachings of Rahn with the teachings of Woltman at the time of the invention for the ergonomic ease of positioning and re-positioning to a desired location (Woltman Col. 4 line 11-12). One of ordinary skill in the

Art Unit: 3643

art would be motivated to make such a modification to direct flow differently to accommodate different size aquariums or to reposition while cleaning the aquarium without removing the system completely. Merely making a modification for the means of adjustability does not present a patentably distinct limitation [*In re Stevens*, 212 F.2d 197, 198, 101 USPQ 284, 285 (CCPA 1954)].

Regarding Claims 2 and 3, Rahn as modified teaches wherein the water intake system, the water return system, and the at least one valve assembly are coupled by at least one connecting piece which is least one of the following: a coupling bracket, a tee bracket, and an elbow bracket (Rahn Fig. 1 and 2 show that elbow brackets are used to couple elements 9, 8, 7, 6, 2, 4).

Regarding Claim 10, Rahn as modified teaches the valve assembly has one or more openings (Rahn Fig. 5 #101 and 102) and a regulator which regulates the rate at which the water returns (Rahn #104).

Regarding Claim 11, Rahn as modified inherently teaches the regulator further comprises an adjustment mechanism to alter the rate at which the water returns (Rahn #117 is dependent on the flow rate coming through #103 which inherently can change and thus change the speed at which #117 operates).

Regarding Claim 12, Rahn as modified teaches a cap which can seal at least one of the openings (Rahn Fig. 5 #104 seals #101).

Regarding Claim 13, Rahn as modified teaches at least one attachment fastens to the opening of the valve assembly (Rahn #7 and 6).

Art Unit: 3643

Regarding Claim 16, Rahn as modified teaches an aquarium spray bar (Rahn #10).

Regarding Claim 17, Rahn as modified teaches at least one pipe connected on each end by at least one connecting piece (Rahn see attached Fig. 1 and 2).

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,782,204 to Rahn in view of U.S. Patent No. 5,098,585 to Woltman as applied to claims 1-3 above, and further in view of U.S. Patent No. 6,080,304 to Gomi.

Regarding Claims 4 and 5, Rahn as modified is silent on wherein the at least one connecting piece is coupled to an attachment mechanism, wherein the attachment mechanism is a suction cup. However, Gomi teaches an aquarium inlet and outlet system with at least one connecting piece couple to an attachment mechanism that is a suction cup (Gomi Fig. 7 #7). It would have been obvious to one of ordinary skill in the art to further modify the teachings of Rahn with the teachings of Gomi at the time of the invention since the general knowledge of one of ordinary skill in the art would want to secure the system to the aquarium, as taught by Gomi (Gomi Col. 6 line 27-33) to prevent undesired displacement. Undesired displacement could be caused by a fish bumping into the connecting pieces or ports.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,782,204 to Rahn in view of U.S. Patent No. 5,098,585 to

Art Unit: 3643

Woltman as applied to claims 1-3 and 9-13 above, and further in view of U.S. Patent No. 6,125,791 to Gunderson et al.

Regarding Claims 14 and 15, Rahn as modified is silent on the at least one attachment includes at least one of a ball/socket assembly, wherein the ball/socket assembly comprises a number of interlocking balls and sockets that can be rotated in at least one direction to allow customizability in water flow pattern. However, Gundersen teaches an aquarium with a ball and socket assembly (Gundersen #62B, 65B, 62B and 64B). It would have been obvious to one of ordinary skill in the art to further modify the teachings of Rahn with the teachings of Gundersen at the time of the invention since the modification is merely the selection of a known alternate equivalent discharge attachment selected for the advantage of controlling the direction of the outflow. It is general knowledge of one of ordinary skill in the art to be motivated to have adjustability/flexibility for the ergonomic ease of fitting within certain space restrictions and for ease of performing maintenance on the system with minimized disruption to the fish. Merely making a modification for the means of adjustability does not present a patentably distinct limitation [*In re Stevens*, 212 F.2d 197, 198, 101 USPQ 284, 285 (CCPA 1954)].

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-5, 9-18, and 30 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

Art Unit: 3643

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, general knowledge available to one of ordinary skill in the art was used to establish obviousness, i.e. adjustable systems have ergonomic advantages (e.g. rotatability) and the desirability to secure the system in a particular configuration to maintain that desired configuration (e.g. suction cups).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent No. 4,817,561

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



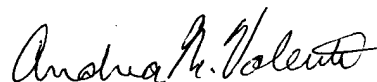
Art Unit: 3643

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea M. Valenti whose telephone number is 571-272-6895. The examiner can normally be reached on 7:00am-5:30pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Andrea M. Valenti  
Patent Examiner  
Art Unit 3643

21 September 2005

Peter M. Poon  
Supervisory Patent Examiner  
Technology Center 3600

